

REMARKS/ARGUMENTS

Claims 4, 19, 45 and 51, 53 and 55 are pending. Claims 1-3, 5-18, 20-44 and 46-50, 52 and 54 are canceled without prejudice or disclaimer of the subject matter they contain. Claims 4, 19, 45 and 51, 53 and 55 are amended to encompass potentially infringing subject matter. By the amendments, Applicants do not acquiesce to the propriety of any of the pending rejections and does not disclaim any subject matter to which they are entitled to claim. Further, Applicants reserve the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

Entry and favorable consideration of the above claim amendment(s) is believed to be appropriate and is hereby respectfully requested because such claim amendments: (a) place the application in condition for allowance; and/or (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify or address issues previously discussed throughout the prosecution). It is believed that the above claim amendments place this application in condition for allowance.

REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects claims 4, 19 and 45 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 07145598 and PROMT 94:375291 taken with Granirer (U.S. Pat. No. 4,759,930). Applicants respectfully traverse this rejection.

JP 07145598 merely teaches disinfectant compositions containing eucalyptus oil, peppermint oil, menthol, mint oil, etc. As in the prior Office Action, the present Office Action acknowledges that JP 07145598 teaches a disinfection effect of the composition (English abstract, for example). However, JP07145598 does not teach or suggest that the disclosed

disinfectant compositions could be reasonably expected to have insect-killing properties, let alone, capable of killing insects or arachnids.

PROMT 94:375291 merely discloses a listing of so called minimum risk compounds that may be eligible for exemption under FIFRA Section 25(b) and used in pesticides. PROMT 94:375291, however, lacks any teaching or suggestion of any specific combinations of the listed compounds. Granirer merely discloses insect-killing compositions that comprise pyrethrum, rotenone, or both, and one or more of the following: eucalyptus, rosemary, peppermint and boric acid (see abstract). Neither PROMT 94:375291 nor Granirer discloses or suggests the specific combination of plant essential oil compounds, as presently claimed. Both PROMT 94:375291 and Granirer, alone or combined, fail to remedy the deficiencies of JP 07145598.

Applicants respectfully submit that the Office Action employs improper hindsight reasoning to assert that the claimed invention would have been obvious. As stated in *In re Soli*, 317 F.2d 941, 947 (CCPA 1963), when the Patent Office finds “differences between the subject matter sought to be patented and the prior art, it may not, without some basis in the logic of scientific principle, merely allege that such differences are either obvious or of no patentable significance and thereby force an appellant to prove conclusively that it is wrong.” Furthermore, the mere fact that the prior art may be modified in the manner suggested in the Office Action is not enough to have make the alleged modification obvious unless the cited references suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

The rationale used to support this rejection includes motivation gleaned only from the Applicant’s disclosure. Specifically, the Office Action fails to show a motivation to combine, or even evidence of motivation to combine, the three cited reference in order to accomplish that of the claimed invention, that does not stem solely from the Applicant. It is well established that

“to imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or referenced of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor teaches is used against its teacher.” See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). Both the suggestion and the reasonable expectation of success “must be founded in the prior art,” not in the Applicants’ disclosure.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988)). Here, neither have been adequately shown. Thus, Applicants respectfully submit that this rejection should be reconsidered and withdrawn.

DOUBLE PATENTING REJECTION

The Office Action rejects claims 19, 52 and 53, under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of U.S. Patent No. 4,759,930. Although Applicants respectfully submit a terminal disclaimer should not be required, Applicants respectfully request that this rejection be held in abeyance until an indication of allowable subject matter. If ultimately deemed necessary, an appropriate terminal disclaimer will be submitted.

CONCLUSION

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner’s Amendment), then please contact the undersigned attorney at the telephone number listed below.

Applicant(s) hereby requests any extension of time deemed necessary for entry of this submission and any submission filed hereafter in this application or any continuing application(s). Applicant(s) makes a Conditional Petition for any relief available to correct any defect in connection with this filing, or any defect remaining in this application after this filing. The Commissioner is authorized to charge any petition fee or any deficiency in fees filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. **14-1140 (please use reference number: WFG-4380-107)** or credit any overpayment of fees to such Deposit Account.

Respectfully submitted,

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